

February 24, 2011

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

Re:	Application Serial No.:	78/852798
	Mark:	DWG
	Filing Date:	April 3, 2006
	Applicant:	Autodesk, Inc.
	Office Action Mailing Date:	August 24, 2010
	Examining Attorney:	Paul E. Fahrenkopf, Law Office 101
	Attorney Docket No.:	5477-TM1001

RESPONSE TO OFFICE ACTION NO. 5

Applicant Autodesk, Inc. (“Applicant”) hereby responds to Office Action No. 5 mailed on August 24, 2010. For the reasons set forth previously and below, Applicant requests that the Examining Attorney withdraw his objection, pursuant to Section 2(e)(1) of the Trademark Act, to registration of Applicant’s mark.

I. Requirement for Information

a. Documents from Case No. 08-04397 (N.D. Cal.)

At the request of the Examining Attorney, Applicant is submitting with this response copies of the amended complaint, answer and order concerning the parties’ motions for summary judgment in the above-cited lawsuit. *See* Exhibit A. In short, United States District Court Judge William Alsup granted in part and denied in part the parties’ respective motions for summary judgment: in pertinent part, Judge Alsup denied summary judgment on defendant’s claims that DWG is generic and that Applicant is not the senior user of the mark and also granted summary judgment on Applicant’s claim that the uses of DWG that Applicant was seeking to prevent were nonfunctional. The parties later settled the lawsuit before trial.

b. Status of Memorandum Opinion in Case No. 08-04397 (N.D. Cal.)

At the request of the Examining Attorney, Applicant advises that neither party appealed the December 31, 2009 “Memorandum Opinion On the Use of ‘DWG’ As a File Extension and Autodesk’s Disavowal Thereof” in the action entitled *Autodesk, Inc. v. Dassault Systemes Solidworks Corporation* in the U.S. District Court for the Northern District of California. The Memorandum Opinion differentiates between computer software file formats, such as “.dwg” (which the Court maintained cannot be controlled exclusively by a trademark owner), on the one hand, and “word marks” for use in packaging, advertising and marketing materials, such as DWG (which the Court maintained are subject to trademark protection), on the other. Significantly, Applicant is seeking to register here the “word mark” DWG, not the file extension “.dwg”.

As set forth above, Applicant is providing a copy of the Court’s summary judgment order from this lawsuit together with this response.

c. Other Proceedings Regarding DWG

At the request of the Examining Attorney, Applicant notes the following U.S. adversary proceedings and lawsuits regarding DWG as a trademark:

<u>Caption</u>	<u>Case No.</u>	<u>Status</u>	<u>Papers Submitted</u>
<i>Autodesk v. Oridus</i> TTAB (Exhibit B)	92046492	Petition for Cancellation granted	Final Order
<i>Autodesk v. Softelec</i> TTAB (Exhibit C)	92047083	Challenged mark assigned to Autodesk; petition withdrawn	Final Order, Trademark Assignment record

<u>Caption</u>	<u>Case No.</u>	<u>Status</u>	<u>Papers Submitted</u>
<i>Autodesk v. Solidworks</i> ¹ TTAB (Exhibit D)	91170857 92046253	Challenged marks surrendered/abandoned; Autodesk's petition granted and opposition sustained; and Respondent's oppositions dismissed with prejudice	Final Order
<i>Autodesk v. O.D.A.</i> TTAB (Exhibit E)	92047002	Challenged marks surrendered; Petition dismissed without prejudice	Final Order
<i>Autodesk v. O.D.A.</i> U.S. Dis. Ct. (Exhibit F)	C06-1637-MJP	Permanent Injunction	Consent Judgment

The papers cited above are being provided to the USPTO together with this response. *See* Exhibits B - F.

Applicant has also been a party to DWG-related adversary proceedings and a lawsuit outside the United States. In each instance the adverse party has withdrawn its objections, if any, to Applicant's DWG trademark. Applicant is prepared to submit documents or information concerning these foreign proceedings, if helpful.

d. Status of Case No. C06-1637-MJP (W.D. Wash.)

At the request of the Examining Attorney, Applicant advises that in the action entitled *Autodesk, Inc. v. Open Design Alliance* in the U.S. District Court for the Western District of

¹ This was a consolidated proceeding also involving opposition Nos. 91174972 and 91175197 filed by respondent against Autodesk's DWGX and REALDWG marks. The DWGX mark has since received a Notice of Allowance and the REALDWG mark has registered.

Washington, Applicant secured a temporary restraining order, and the Court later entered a consent judgment, among other things, permanently enjoining defendant from simulating Applicant's "TrustedDWG" technology.

II. Additional Documents and Information Submitted by Applicant

Applicant has previously submitted extensive evidence of the distinctiveness of its DWG mark, including multiple declarations, a consumer survey and other materials. Applicant is now submitting with this response, among other things, the following additional evidence:

- Data concerning revenue, software licenses, and Web traffic (Exhibit G (Declaration of Shawn Gilmour, hereinafter "Gilmour Decl.") at ¶¶ 3-4, 8);
- Registration certificates for Applicant's DWG mark from Canada, Australia, Japan, China, Spain, Mexico and Benelux (Gilmour Decl., Exhibits 25-32);
- A document showing provisional acceptance of Applicant's DWG trademark applications in the United Kingdom, based on evidence of acquired distinctiveness, and in Brazil (Gilmour Decl., Exhibits 34-35);
- USPTO documents showing registration of Applicant's marks REALDWG and RASTERDWG, and allowance of Applicant's mark DWGX (Gilmour Decl., Exhibit 33; Exhibits H and I)²;

² Applicant's applications to register the marks DWG AND DESIGN, DWG TRUEVIEW, DWG TRUECONVERT, and DWG EXTREME remain suspended. *See* Serial Nos. 78852808, 78852813, 78852822, and 78852843. Applicant's U.S. application to register TRUSTEDDWG was allowed and then abandoned; Applicant subsequently filed a new application for TRUSTEDDWG, and that application is pending. *See* Serial No. 85107136. Applicant also owns registrations for various DWG-related trademarks in other jurisdictions.

- The WHOIS record showing Applicant's ownership of the <dwg.com> Internet domain name (Exhibit J);
- Evidence of the company's use of the following DWG-related brands over time:
100% PURE AUTOCAD DWG (AND DESIGN), MAX DWG, DWG UNPLUGGED, AUTODESK VIEW DWGX, DWG EXTREME, DWG LINKING, DWG TRUE CONVERT, DWG TRUEVIEW, REALDWG, DWG (AND DESIGN) AND RASTERDWG (Gilmour Decl., Exhibits 2-10, 16 and 17); and
- Information summarizing Applicant's widespread distribution of distinctive DWG computer file icons -- which Applicant estimates has been displayed on the computer screens of millions of software users -- during the time period 2003 to the present (Gilmour Decl. at ¶ 5, Exhibit 1).

III. Letters of Protest

The Examining Attorney cites Letters of Protest granted on March 16, 2010 and May 21, 2010. These were filed by, respectively, the Open Design Alliance, the respondent in one of the above-cited TTAB proceedings and the defendant in the above-cited federal court lawsuit in which Applicant secured both a temporary restraining order and permanent injunction, and by Nemetschek North America, Inc., one of Applicant's competitors and a member of the Open Design Alliance. The Letter of Protest from the Open Design Alliance includes three declarations and documents, and the Letter of Protest by Nemetschek North America attaches a copy of Judge Alsup's December 31, 2009 Memorandum Opinion, which is discussed above.

The Letter of Protest from the Open Design Alliance is questionable and needs to be understood in proper context. First, each of the supporting declarations is legally defective and

thus should be given minimal weight.³ Second, a number of the cited definitions of “dwg” are, within the context of computer software, antiquated (*see, e.g.*, 1946, 1956, 1966 and 1974 definitions); other citations, such as those to obscure government documents, are isolated and dated -- they do not reflect consumer perception in today’s market for computer-aided design (CAD) products. Third, other supporting documents focus primarily on technical distinctions related to “.dwg” as a software file extension, and not, as is appropriate here, on DWG as a brand for goods or services.⁴

IV. Section 2(e) Refusal and Applicant’s Section 2(f) Claim

The Examining Attorney has maintained a refusal to register Applicant’s mark, pursuant to Section 2(e)(1), and has deemed Applicant’s Section 2(f) evidence insufficient to establish distinctiveness. For the reasons previously stated, and in light of the additional evidence now submitted, Applicant respectfully requests that the Examining Attorney withdraw his objections.

a. Trademarks Corresponding to File Extensions

The USPTO has on a number of occasions registered trademarks that correspond to the names of computer software file extensions. Here are some illustrative examples:

³ In particular, the declarations by Arnold van der Weide, Mike Riddle and Mike Wolmoth lack any statement of awareness of the penalty of perjury, in violation of federal statute. 28 U.S.C. § 1746. As a result, each declarant “is not declaring or subjecting himself to anything.” *See, In re Dermahuse Inc.*, 82 U.S.P.Q. 2nd 1973 (2007); *see also*, TMEP § 80401(b) (“A declaration that does not attest to an awareness of the penalty of perjury is unacceptable.”); *In re Hoffman-LaRoche Inc.*, 25 U.S.P.Q. 2d 1539 (Comm’r Pats. 1992); *In re Stromshulmers Mekaniska Verkstad AB*, 228 U.S.P.Q. 908 (T.T.A.B. 1986); *In re Laboratories Gapil, S.A.*, 197 U.S.P.Q. 689 (Comm’r Pats. 1977).

⁴ It is noteworthy that the author of this Letter of Protest, the Open Design Alliance, has surrendered to the USPTO each of its DWG-related trademark registrations. *See*, Reg. Nos. 2672409, 2920269, 2656757, 2517750, 2563976, and 2719529.

Computer File Extension Name	Mark as Registered	Reg. No.	Software Type	Registration Owner
.fbx	FBX	2676937	3D graphics development	Autodesk, Inc.
.pages	PAGES	3044896	word processing	Apple Inc.
.java	JAVA	2178784	software platform	Oracle America, Inc.
.nes	NES	1721018	gaming	Nintendo of America Inc.
.x3f	X3F	2939661	digital camera imaging	Foveon, Inc.
.dng	DNG	3484827	digital camera imaging	Adobe Systems Inc.
.bsb	BSB	3026152	nautical chart imaging	Maptech, Inc.
.sat	SAT	2342417	3D modeling	Spatial Technology, Inc.

There is no principled reason to distinguish Applicant's mark from these marks. Moreover, the Trademark Trial and Appeal Board, in perhaps its only decision addressing trademark protection for names that correspond to file extensions, has taken the (non-precedential) position that computer file format names and trademarks are not mutually exclusive:

[T]he evidence of record indicates that [the mark] serves both as an initialism for a method of transferring digital images . . . and also as a mark used to identify goods conforming with that standard Nonetheless, the examining attorney has cited to no authority to support a finding that a term used to denote such a method is incapable of distinguishing applicant's goods from those of others.

In re Fuji Photo Film Co., Ltd., Ser. No. 75580709 (December 19, 2006). Here the USPTO has not cited, and Applicant is not aware of, any contrary legal authority.

Applicant is seeking trademark protection for its DWG brand. Such protection is not precluded because the brand is similar to a computer file format.

b. Secondary Meaning

Given the considerable weight of the evidence submitted by Applicant, there should not be any doubt about the distinctiveness of Applicant's mark. To recap, Applicant has now

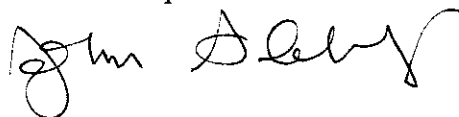
submitted in support of this application: evidence of Applicant's use, in general, of "dwg" dating back to the early 1980's; evidence of Applicant's DWG-related brands dating back to the 1990's; examples of Applicant's DWG-related file icons dating back to 2003; software license data; marketing data; revenue data; Web traffic data; consumer survey data; dictionary definitions; and trademark registrations and allowed applications for the same DWG mark from other jurisdictions. In considering a claim of acquired distinctiveness, "the issue is whether acquired distinctiveness of the mark in relation to the goods or services has in fact been established *in the minds of the purchasing public . . .*" Trademark Manual of Examining Procedure ("TMEP") § 1212.06 (emphasis added). Here, there should be no question, based on all the evidence submitted, that the distinctiveness of the mark has been established in the minds of the purchasing public.

V. Conclusion

Applicant maintains that the application is now proper for publication and requests that it be forwarded.

Respectfully Submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

A handwritten signature in black ink, appearing to read "John Slafsky", written over the printed name.

John L. Slafsky
Attorneys for Applicant